

DETAILED ACTION

1. Claims 1-165 are presented for examination.
2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,93,919 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely appraise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Amendment to Reissue application

3. The amendment filed 4/12/01 proposes amendments to the claims and the amendment filed 2/19/02 proposes amendments to the drawings that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required. Because underline marking is missing on newly added claim 14 (see amendment filed on 4/12/01). Also changes to the drawings filed on 2/19/02 must be included a replacement sheet of drawings which shall be an attachment to the

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amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings. See 37 CFR 1.173(b)(3) and MPEP § 1414 and 1453.

The amendments to the claims filed on 4/12/01 and 2/19/02 are defective for failure to comply with provisions of 37 CFR 1.173.

Although applicant include a very general statement for support for claim changes (applicant "Remark" filed on 2/19/02), however, each change made in the claim is not being accompanied by a concise explanation of the support in the disclosure of the patent for the change made to the claim (i.e., support for all changes made in the claims, whether insertions or deletions) (37CFR 1.173 C and MPEP 1453). In other words, the claimed subject matter for each of the claims is not clearly mapped to the specification by page and line number, and to the drawing, if any, by reference characters. A concise explanation of the subject matter defined in each of the claims involved in the reissue amendment, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply

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summarizing the invention, it is considered important to enable the Examiner to more quickly determine where the claimed subject matter is described in the application. Also every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. Also support for a program storage medium and a computer readable medium should be provided to prevent possible 112 1st paragraph and 101 rejections. Applicant did not clearly point out what is changed in the "Remarks" portion of the amendment. A clear explanation on each of the newly added claims 11-165 filed on 4/12/01 and 2/19/02 should appear in the remarks (see MPEP 1453).

A shortened statutory period for reply to this letter is set to expire ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this letter.

4. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b). In addition, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See MPEP § 1414.01. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b). In addition, when

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any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See MPEP § 1414.01.

Oath/Declaration

5. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because the declaration does not specifically identifying the error. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies in error. It appears as though applicant is saying that the not requirement of the “parity information” limitation from the claims is the error, however, the new issue claims also contain “parity” (i.e. claim 35, “at least one parity block”). There should be more specificity including an indication of where in the specification the embodiment now being claimed can be found.

A new reissue oath or declaration in compliance with 37 CFR 1.175 is required. See MPEP § 1414.

6. Claims 11-165 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Information Disclosure Statement

7. Acknowledgment is made of applicant's Information Disclosure Statement (IDS) Form PTO-1449, filed on 8/2/01, 2/7/02, 4/8/02, 5/17/02, 8/8/02, 8/19/02, 5/20/03, and 8/25/04. In an attempt to fulfill Applicant's duty to disclose information which is material to patentability according to 37 CFR 1.56, Applicants have submitted a large number of documents for the Examiner to consider. Documents filed on 8/25/04, cited numbers 6 thru 11, and the documents filed on 5/20/03 sheets 15-16 were considered, however, it appears that those are not material to patentability and should not have been submitted. Also it appears from a cursory review of the rest of documents that the vast majority of them are not material to patentability and should not have been submitted. In fact, the sheer number of documents creates an undue burden on the Examiner since if each document is material to patentability, each document must be carefully considered.

According to MPEP 609 (emphasis added): Although a concise explanation of the relevance of the information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

Additionally, Applicant is made aware of the court decision in *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., et al.*, 175 USPQ 260 (DC SFla, 1972) which stated that “Applicant has obligation to call most pertinent prior patent to attention of Patent Office in a proper fashion and to attempt to patentably distinguish his claimed invention from disclosure of patent; failure to take these affirmative steps, particularly when coupled with misrepresentations made to the Patent Office, renders unenforceable the patent issued on his application.” Apparently a good reference was buried in the mountain of prior art in the case and never pointed out by the Applicant.

Applicant is requested/reminded that only documents which are “material to patentability” should be submitted. See 37 CFR 1.56 for definition of materiality.

Accordingly, the documents filed on 8/25/04, cited numbers 6 thru 11, and the documents filed on 5/20/03, sheets 15-16 were considered, however, the rest of documents on the information disclosure statements have not been considered.

Applicant should submit a new IDS containing only those documents which are material to patentability, and Applicant should call Examiner’s attention to particular passages and/or figures of particular documents. Resubmission of the previously submitted documents is not necessary.

Conclusion

1. When responding to the office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show

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how the amendments avoid such references or objections. See 37 CFR 1.111(c).

2. When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist examiner to locate the appropriate paragraphs.

3. A shortened statutory period for reply to this letter is set to expire ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this letter.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hong C Kim whose telephone number is (571) 272-4181. The examiner can normally be reached on M-F 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sanjiv Shah can be reached on (571) 272-4098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 whose telephone number is (571) 272-2100.

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5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6. **Any response to this action should be mailed to:**

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to TC-2100:
(571)-273-8300

Hand-delivered responses should be brought to the Customer Service Window (Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

/Hong Kim/
Primary Examiner, Art Unit 2185
January 12, 2008